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Opposition

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No. 75/863,261

Filed: December 3, 1999

Mark: Graphic Logo

Published in the Official Gazette: December 4, 2001, Page TM 206

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AVX Corporation

Opposer,

v.

SIEMENS AKTIENGESELLSCHAFT CORPORATION,

Applicant.

Opposition No: \_\_\_\_\_

**NOTICE OF OPPOSITION**

Opposer, AVX Corporation, believes that it will be damaged by registration of the triangular-shaped Graphic mark shown in Serial No. 75/863,261, which was published in the Official Gazette on December 4, 2001, and hereby opposes same.

As grounds for this opposition, it is alleged that:

1. Siemens Aktiengesellschaft Corporation (hereafter "Applicant") is a corporation of the Federal Republic of Germany, having offices in Munich, Germany.
2. AVX Corporation (hereafter "Opposer") is a Delaware corporation having corporate headquarters in Myrtle Beach, South Carolina. Opposer has offices at various locations in the United States, and at other locations around the world.

3. As evidenced by publication of the triangular-shaped graphic mark on page TM 206 of the December 4, 2001, edition of the Official Gazette, Applicant has filed an application (assigned Serial No. 75/863,261; hereafter "the subject application") for registration of the triangular-shaped graphic mark (hereafter "the subject mark" or "the triangular-shaped graphic mark") for "a full line of electrical engineering and electronic components and devices for the telecommunications, automotive electronics and industrial and consumer electronics industries, and electronic parts and components, namely, filters for electrical signals, surface acoustic wave components, namely, surface acoustic wave filters and surface acoustic wave apparatus for radio frequency applications, ceramic components, namely, thermistors, varistors, low temperatures co-fired ceramic (LTCC) modules, piezo electronic actuators, surge voltage arresters, switching spark gaps and microwave ceramics, EMC components and **capacitors**, namely, conversion filters, power **capacitors**, tantalum chip **capacitors**, aluminum electrolytic **capacitors**, **ultracapacitors**, chokes and filters, ferrites, ferrite cores and inductive ferrite components, namely inductors and inductive ferrite cores," all in International Class 9.

4. The subject application was filed on an intent-to-use basis on December 3, 1999, and claimed the benefit under Section 44 of a German Registration (No. 39942000) that registered on 12 August 1999 from an application filed on 16 July 1999. Applicant has not alleged that any use of the subject mark occurred in commerce (as "commerce" is defined in 15 U.S.C. § 1127) prior to the filing date of the subject application.

5. Upon information and belief, the subject mark has not been used in commerce (as "commerce" is defined in 15 U.S.C. § 1127) prior to July 16, 1999, by Applicant or by another on behalf of Applicant.

6. On April 24, 2001, Opposer filed an application to register its stylized "A" Graphic logo mark for **capacitors**, alleging a date of first use and first use in commerce of April 16, 1999. Opposer's application was assigned Serial No. 76/245,660 (hereafter "Opposer's application").

7. Prior to the 16 July 1999 filing date of the German priority application to the subject application, Opposer has used Opposer's stylized "A" Graphic logo mark on capacitors in commerce (as "commerce" is defined in 15 U.S.C. § 1127) and has not abandoned such usage. Prior to the filing date of the German priority application to the subject application, Opposer's capacitors branded with Opposer's stylized "A" Graphic logo mark have been used in a variety of industries in the United States.

8. Since at least April 16, 1999, through the present, Opposer has been identified in some manner with its Stylized "A" Graphic logo mark. On information and belief, Opposer has developed valuable goodwill in respect to its stylized "A" Graphic logo mark by virtue of its efforts, the expenditure of sums for promotional activities, and the excellence of Opposer's products.

9. Through widespread and longstanding use, Opposer has developed substantial common law rights in relation to its stylized "A" Graphic logo mark. These common law rights of Opposer predate the filing date of the German priority application to the subject application. The stylized "A" Graphic logo mark possesses a high degree of distinctiveness, and is well-known and recognized as identifying goods that have their

source with Opposer, and serves to distinguish those goods from the goods of others. The common law rights of Opposer in the stylized "A" Graphic logo mark represent a valuable asset and symbol of the goodwill of the business that Opposer has built over the years.

10. Opposer has superior rights in and to its stylized "A" Graphic logo mark than Applicant has in and to Applicant's triangular-shaped graphic mark because Opposer's usage of Opposer's stylized "A" Graphic logo mark predates the 16 July 1999, filing date of the alleged German priority application allegedly claimed in the subject application to register Applicant's triangular-shaped graphic mark.

11. On information and belief, the goods set forth in the subject application are intended to move through channels of trade established in the electronic industry, and these channels are the same as or at least intersect the channels of trade in which the goods of Opposer move under Opposer's stylized "A" Graphic logo mark. On information and belief, Applicant intends to market its capacitors and other related electronic components bearing the Applicant's triangular-shaped graphic mark in the same channels of trade as Opposer markets its capacitors branded with Opposer's stylized "A" Graphic logo mark.

12. Applicant's triangular-shaped graphic mark has been deemed by the Trademark Office to bear sufficient resemblance to Opposer's stylized "A" Graphic logo mark such that in a communication mailed on July 16, 2001, Opposer was informed that Opposer's application was suspended pending the disposition of the subject application, which the Office indicated may be cited against Opposer's application when the subject application registers. Thus, on information and belief, Applicant's triangular-shaped graphic mark so resembles Opposer's stylized "A" Graphic logo mark previously used

by Opposer in the United States and not abandoned, that Applicant's triangular-shaped graphic mark is likely, when used on or in connection with the goods of Applicant, to cause confusion, or to cause mistake or to deceive.

13. On information and belief, customers of both Opposer and Applicant are likely to be confused in that they will believe there is some sponsorship of Applicant's goods by Opposer or vice versa. Customers familiar with Opposer's stylized "A" Graphic logo mark and Opposer's reputation in the field of capacitors and related electronic components would be likely to buy Applicant's products, including capacitors, branded with Applicant's triangular-shaped graphic mark, as and for a product made and sold by the Opposer. Any such confusion in trade inevitably would result in loss of sales to the Opposer.

14. On information and belief, any defect, flaw, objection or fault found with Applicant's products marketed under the Applicant's triangular-shaped Graphic logo sought to be registered by Applicant would necessarily reflect upon and seriously injure the reputation that the Opposer has established for its products merchandised under Opposer's stylized "A" Graphic logo mark.

15. Opposer is likely to be damaged by Applicant's registration of its triangular-shaped Graphic logo mark in that the prima facie effect of such registration will tend to impair Opposer's right to use its stylized "A" Graphic logo mark.

16. If Applicant is granted the registration herein opposed, Applicant would thereby obtain at least a presumptive exclusive right to the use of Applicant's triangular-shaped graphic mark. Such registration would be a source of damage and injury to the Opposer.

In view of the above, Applicant is not entitled to federal registration of the triangular-shaped Graphic logo mark of the subject application.

WHEREFORE, Opposer prays that the subject application be denied and refused, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

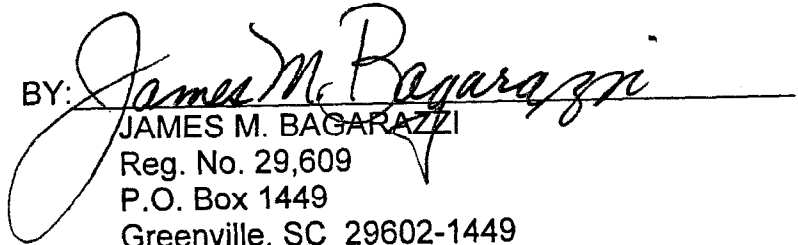
The requisite \$300 fee and two copies of this Notice are submitted herewith.

Respectfully submitted,

DORITY & MANNING, P.A.

DATED: Feb. 1, 2002

BY:

  
JAMES M. BAGARAZZI  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

EXPRESS MAIL CERTIFICATE

"Express Mail" Mailing Label Number: EV106944995US

Date of Deposit: August 8, 2002

I hereby certify that the attached paper and/or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Box TTAB, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Denise R. Ginn

(Typed or printed name of person mailing paper or fee)

Denise R. Ginn

(Signature of person mailing paper or fee)

Opposition No: 91/150,971

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Opposer,

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08-08-2002

v.

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Siemens Aktiengesellschaft,

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**SERVICE OF ANOTHER COPY OF THE ORIGINAL NOTICE OF OPPOSITION**

In compliance with the Order of the Board dated August 1, 2002, Opposer hereby serves on the Applicant's attorney and on the Board, by Express Mail, postage prepaid, Express Mail No. EV154934661US (Applicant) and Express Mail No. EV106944995US (Board), a copy of the original Notice of Opposition that was filed with the Board on February 1, 2002.

Respectfully submitted,

DORITY & MANNING, P.A.

DATED: August 8, 2002

BY: James M. Bagarazzi

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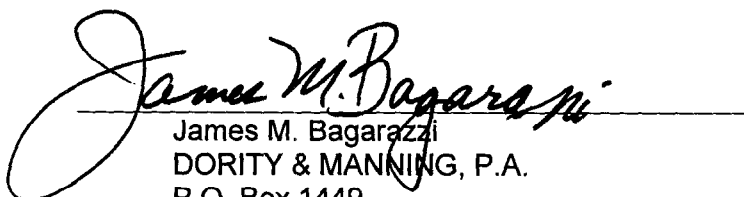
CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing SERVICE OF ANOTHER COPY OF THE ORIGINAL NOTICE OF OPPOSITION was served by Express Mail, No. EV154934661 US, on the date written below and addressed to counsel of record as follows:

Marie Ann Mastrovito, Esquire  
Abelman, Frayne & Schwab  
150 East 42nd Street  
New York, NY 10017

Date:

August 8, 2002

  
James M. Bagarazzi  
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